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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,730	10/11/2001	Juha Telimaa	214910US6	6056

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EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,730

Applicant(s)

TELIMAA ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-11-01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the three sets of threading including that of the calibration mechanism and the two retainers must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Where are the calibration element and its set of threads shown and labeled in the drawings?

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 29 (outer casing). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Interpretations

3. Claim 1 is interpreted as requiring a first and second retainers including respectively first and second threading and a calibration mechanism also having a calibration threading and a corresponding threading; wherein the pitch of the second threading is less than that of the first threading.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no basis for the device comprising a calibration mechanism with the threading as claimed in addition to the first and second retainers. The specification only provides support for the device comprising two sets of threading simultaneously.

5. The amendment filed June 6, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has amended the specification to define threading 17 as the calibration threading. The specification nor claims previously defined the threading as being an element of the calibration mechanism. Applicant has also amended the specification recite the groove 13 is a second threading. The specification nor claims did not previously define the groove as neither being nor comprising threading as further explained herein.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the device comprising 3 sets of threading as claimed. The specification only provides for the device comprising two sets of threading as included within the first and second retainer. One retainer element is disclosed as being comprised of nut 18 which is threaded with fine adjustment sleeve 12 and the second retainer element comprises nut 6 threaded on shaft 3. Where is support in the specification for the device comprising a calibration mechanism comprising the threading as claimed in addition to the two retainers and respective threading?

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation the claim states a range adjustment of the second threading is less than equal to one revolution an adjustment sleeve.

It is unclear if applicant intends to claim an adjustment sleeve as an element of the invention. However, as presently drafted the adjustment sleeve is merely mentioned as a means of comparison to the second threading. The sleeve should be positively claimed as an element of the invention. Furthermore it is unclear how a threading range may be different from the threading which corresponds to it. In order for a nut to fit on a bolt, the nut and bolt must have an equivalent thread range/pitch otherwise the nut will not screw on the bolt. Therefore, pitch/range of a sleeve comprising a second corresponding threading and the second threading must be equal.

Response to Arguments

10. Applicant's arguments filed June 6, 2005 have been fully considered but they are not persuasive.

In response to the previous rejection applicant asserts the threading 17 of the fine adjustment sleeve 12 is the calibration threading which is a part of the calibration mechanism and has amended the specification to indicate such. This is new matter. The "calibration mechanism" has only been referenced in original claim 1. It has not previously defined as being comprised of any specific elements nor mentioned in the specification. It is now improper for applicant to now attempt to define the "calibration mechanism" as being comprised of components which were never referenced as such. The specification previously on mentioned "calibration system" (page 2) and "calibration arrangement" (page 4). Neither of those terms are defined by any specific elements.

The last paragraph of page 2 merely states "the calibration system can be connected for instance to the fine adjustment arrangement". This statement is not sufficient support to now claim or assert the threading inside the top end of the fine adjustment sleeve is the calibration threading.

Applicant further asserts the groove 13 comprises the second threading. Eventhough the groove has not been defined as or mentioned as including threading, applicant asserts the groove is a thread in the broad sense of the word. The examiner respectfully disagrees. This is new matter for the groove was not previously defined as a thread. Furthermore, figures merely show a slot. There is no threading presented or shown. How can a groove or what appears to be a slot comprise threading? Page 5, lines 19-20, states, "the jacket of the fine adjustment sleeve is cut by a groove 13 with a fairly low-gradient pitch." The meaning of the statement is not exactly clear. Does the statement mean the groove has a pitch or the fine adjustment sleeve is cut by the groove and it is the fine adjustment sleeve which has a low-gradient pitch? However, it is clear that the statement does not specifically define the groove as being or comprising threading. Simply reciting the groove has a pitch does not constitute nor translate into the inclusion of threading. When the term "pitch" is used to describe threading, it is understood that this refers to the distance between adjacent threads. When the term is used in relationship to a groove, it is not inherent that a groove comprises threading. Used in the description of a groove or slot, the term "pitch" may imply or be interpreted as the groove/slot is slanted, inclined, angled, or sloped at a particular degree (all equivalent to the term pitch). The drawings do not show the

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groove as having threading nor being sloped therefore it remains unclear what is meant by the groove with a low-gradient pitch, but it is clear that no threading is present for the original specification nor claims describe the groove as such.

Applicant has previously amended claim 1 to recite a calibration mechanism comprising a calibration thread and a corresponding calibration threading in addition to the device comprising a first and second retainers comprising threading and corresponding threading. This is considered new matter for there is no support in the specification for the device comprising 3 sets of threads (see remarks). The specification briefly mentions the element of a calibration system as being optionally connected to one of the retainer elements or just being present. This implies that the calibration system is separate from the retainer elements and does not inherently mean the calibration is an element of the retainer elements. The specification does not disclose the particular structure of the element being constructed as claimed. For example:

"In addition, the pipette comprises a calibration system." Page 2, line 11

"The nut 18 is attached to the retainer sleeve 10 so tightly that it is virtually not turned along with the retainer sleeve. When necessary, a suitable adhesive can also be used for this purpose. The top surface of the nut is provided with slots by which the nut can be turned for instance by using a suitable

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tool. Also the pipette calibration is carried out by means of the nut." Page 6, lines 17-21

The above paragraph implicates the calibration mechanism (not specifically defined in the specification or claims) and nut 18 (corresponding thread to threading 17) as being the same element.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

brg


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